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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,613	04/06/2001	Eric J. Sprunk	18926-003140	6987
20350	7590	05/19/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			DEMICCO, MATTHEW R	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/827,613

**Applicant(s)**

SPRUNK, ERIC J.

**Examiner**

Matthew R. Demicco

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date See Office Action.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 12/7/04, 5/10/04, 8/9/02, 3/25/02, 2/20/02, 2/19/02 and 7/16/01 have been considered by the examiner.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 4, 416; Figure 8, 812; Figure 10, 1012, 1028 and 1032; Figure 12, 1220; Figure 13, 1324; Figure 16C, 1662 and 1674; Figure 17, 1714, 1720 and 1724. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

2. The disclosure is objected to because of the following informalities: On Page 20, Line 22, set top box "1518" should be corrected to --108--. Appropriate correction is required.

*Claim Objections*

3. Claims 27 and 28 are objected to because of the following informalities: Claim 27 cannot depend from itself. The Examiner believes that both Claims 27 and 28 more appropriately depend on parent Claim 26. For purposes of examination, the claim dependencies will be treated as such. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-17 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,654,746 to McMullan, Jr. et al.

Regarding Claim 1, McMullan discloses a method for securing an object associated with a content receiver that is part of a conditional access system comprising receiving the object (video game data, Col. 3, Lines 49-53 and Col. 5, Lines 38-50) by the content receiver (See Figure 1, 177) and loading the object into memory (Col. 6, Line 64 – Col. 7, Line 12). A user is able to use the system for specific amounts of time

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(arcade mode, Col. 10, Line 58-63 and Col. 11, Lines 4-12). Upon ordering a game, an authorization message including an amount of playtime is transmitted to the user's terminal (Col. 11, Lines 29-38). During play, a memory storing the amount of time available is decremented for each time unit of play (Col. 14, Lines 35-43). This reads on the claimed beginning a timer counting (decrementing the playtime available). Continual checks are made to determine if the amount of playtime available stored in memory reaches zero (playtime expires) so that the system may terminate game play (Col. 7, Lines 57-61, Col. 12, Lines 29-30 and Col. 14, Lines 40-43). This reads on the claimed determining when the timer expires and executing an event that correlates with the determining step (if remaining playtime is zero, halting play). Further, since the playtime available stored in memory is now zero, the system will no longer allow a user to begin playing another game (Col. 12, Lines 7-23). This reads on the claimed changing an authorization status (setting playtime to zero) based on the determining step.

Regarding Claim 2, McMullan discloses a method as stated above in Claim 1, wherein the executing step comprises the step of executing an action in correlation to the determining step as stated above. This action (continuing or halting game play if playtime has or has not expired) reads on the claimed checkpoint.

Regarding Claim 3, McMullan discloses a method as stated above in Claim 2, wherein the checkpoint either authorizes play (timer has not reached zero) or de-authorizes play (timer has reached zero). This reads on the claimed authorizing use of the object by the content receiver.

Regarding Claim 5, McMullan discloses a method as stated above in Claim 1, further comprising a step of changing the authorization status based on the executing step as stated above in Claim 3.

Regarding Claim 6, McMullan discloses a method as stated above in Claim 1, wherein the receiving step comprises downloading the object from an authorized data channel (Col. 5, Lines 38-39) in an encrypted form (Col. 7, Lines 20-25).

Regarding Claim 7, McMullan discloses a method as stated above in Claim 1, wherein the loading step comprises the step of loading the object in volatile memory (DRAM, see Figure 2).

Regarding Claim 8, McMullan discloses a method as stated above in Claim 1, wherein the beginning step comprises a step of receiving the playtime data as stated above. This reads on the claimed determining a time value (amount of playtime available to the user) that the timer measures.

Regarding Claim 9, McMullan discloses a method as stated above in Claim 1, wherein the determining step is executed on a security processor (ASIC 200, Col. 14, Lines 40-43) separate from a general-purpose processor (Col. 6, Lines 6-7).

Regarding Claim 10, McMullan discloses a method as stated above in Claim 1, further comprising a step of removing the object from the memory (by resetting the device) based upon the changing step as stated above.

Regarding Claim 11, see Claims 1 and 2 above.

Regarding Claim 12, see Claim 3 above.

Regarding Claims 13-15, see Claims 5-7 above, respectively.

Regarding Claim 16, see Claim 8 above. The time valued is a predetermined value based on the amount of time the user has purchased (Col. 11, Lines 10-12).

Regarding Claim 17, see Claim 10 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan, Jr. et al. in view of U.S. Patent No. 5,581,270 to Smith et al.

Regarding Claim 4, McMullan discloses a method as stated above in Claim 1.

What is not disclosed, however, is that the executing step comprises a step of querying a user of the receiver for purchase of the object. Smith discloses a user terminal for receiving gaming content (Col. 3, Lines 58-64) wherein a guest is operable to purchase an amount of playtime and a check is made to see if the playtime has been exceeded (Col. 10, Lines 8-11). When the user runs out of playtime, a menu is displayed including an option to buy more time (Col. 10, Lines 11-15). Once more time is purchased, the system is operable to continue game play (Col. 9, Lines 19-27). This reads on the claimed querying a user for purchase of the object. Smith is evidence that one of ordinary skill in the art would appreciate the ability to allow a user to purchase continued use of an interactive offering. Therefore, it would have been obvious to one having ordinary skill in

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the art at the time the invention was made to modify the method of McMullan with the additional playtime purchase of Smith in order to increase revenue by allowing continued use of a service without forcing a user to leave a game in progress.

Regarding Claim 18, see Claims 1 and 4 above.

Regarding Claim 19, McMullan in view of Smith disclose a method as stated above in Claim 18. McMullan further discloses that the terminal is operable to receive authorization including playtime (Col. 11, Lines 29-37) in an encrypted communication (Col. 7, Lines 20-25) from the service provider. This reads on the claimed remotely changing a time for the content receiver using encrypted commands wherein the timer is correlated to the time.

Regarding Claim 20, McMullan in view of Smith disclose a method as stated above in Claim 18. Smith further discloses that if the user opts to purchase more time, game play is allowed to continue as stated above in Claim 4. This reads on the claimed changing the authorization status based on the querying step.

Regarding Claim 21, see Claim 16 above.

Regarding Claims 22-25, see Claims 7-10 above, respectively.

Regarding Claim 26, see Claim 18 above. The beginning a timer counting and determining when the timer expires of Claim 18 read on the claimed beginning a usage counter counting and determining when the usage counter reaches a limit.

Regarding Claim 27, see Claim 20 above.

Regarding Claim 28, see Claim 10 above.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R. Demicco whose telephone number is (571) 272-7293. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*mrd*

mrd

May 10, 2005

*Chris Grant*  
CHRIS GRANT  
PRIMARY EXAMINER